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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,019	04/08/2004	Hiroyuki Utsumi	1450.1004C	7567
21171	7590	06/19/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CAO, CHUN	
			ART UNIT	PAPER NUMBER
			2115	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,019

Applicant(s)

UTSUMI ET AL.

Examiner

Chun Cao

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/666,593.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/08, 10/27, 06/03, 12/20</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 are presented for examination.

Specification

2. The abstract of the disclosure is objected to because in line 5. "wad" should be -- was--. Correction is required. See MPEP § 608.01(b).

Appropriate correction is required.

Claim Objections

3. Claims 1, 4 are objected to because of the following informalities: in claim 1, line 6, "an area design register" should be -- an area designation register--; in claim 4, line 5, "an address inhibiting section" should be -- an access inhibiting section--. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 8, 10, 12, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the processor" in line 4. There is insufficient antecedent basis for the limitation in the claim; in line 4 it is not clear where the other processor is.

In claims 8 and 15, the limitations "a memory storing a start address of the initialization program stored is selected based on the reset signal" is not clearly understood.

Claim 10 recites the limitation "the initial reset signal " in line 1. There is insufficient antecedent basis for the limitation in the claim.

Claim 12 recites the limitation "the initial reset signal " in line 1. There is insufficient antecedent basis for the limitation in the claim.

Claim 17 recites the limitation "the initial reset signal " in line 1. There is insufficient antecedent basis for the limitation in the claim.

Claim Rejections - 35 U.S.C. § 101

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,748,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because In view of the "obviousness-type" double patenting rational enunciated in *Georgia Pacific Corp v United States Gypsum Co.*, 52 USPQ2d 1590, U.S. Court of Appeals Federal Circuit 1999, application claims 1-25 merely define an obvious variation of the invention claimed in the U.S. Patent 6,748,527.

After analyzing the language of the claims, it is clear that claims 1-25 of the instant application is merely a **subset** of claims 1-26 of the '527 patent, and thus is an obvious variation of claim 1 of the '527 patent. Initially it should be noted that the present application of parent patent 6,748,527, having the same inventive entity. The Assignee in both applications is the same. The entire disclosures of the instant application and the patent are identical; and the instant application are claiming common subject matter, as follows: The subject matter recited in claims 1-25 of instant application -- "performing a software initialization using an initialization program after performing an initialization in response to a reset signal" are fully disclosed in claims 1-26 of U.S. Patent 6,748,527 respectively.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2 and 7-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirano et al. (Hirano)¹, U.S. patent no. 5,361,365.

As per claim 1, Hirano discloses a data processing system performing a software initialization using an initialization program after performing an initialization in response to a reset signal [figures 1, 2], the system comprising:

an address selecting section [1, fig. 1; 21, fig. 2] selecting a start address of the initialization program stored in a memory based on an address selection signal; and an area designation register to designate an address area of the memory [col. 5, lines 40-47; col. 6, lines 13-29, 38-60].

As per claim 2, Hirano discloses that the initialization is a hardware initialization [col. 5, lines 31-37].

¹ Hirano is a reference cited by applicant.

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As per claim 7, Hirano discloses that a data processing system performing a second initialization using an initialization program after a first initialization [figures 1, 2], the system comprising:

a reset register storing a reset signal, wherein the initialization program executes processing selectively based on the reset signal [col. 4, lines 60-62; col. 5, line 7-col. 6, line 21].

As per claim 8, Hirano discloses that a memory storing a start address of the initialization program is selected based on the reset signal [col. 5, lines 34-col. 6, line 21].

As per claim 9, Hirano discloses that the memory is a local memory or an external memory [col. 4, lines 61-65].

As per claim 10, Hirano discloses that an initial reset signal is one of a plurality of reset signals [col. 1, lines 21-27].

As per claim 11, Hirano discloses that a data processing system performing software initialization using an initialization program in response to a reset signal [figures 1, 2], the system comprising:

an address designation section to designate an address area of a memory that stores a start address of the initialization program based on the reset signal [col. 5, lines 40-47; col. 6, lines 13-29, 38-60].

As per claim 12, Hirano discloses an initial reset signal is one of a plurality of reset signals [col. 1, lines 21-27].

As per claim 13, Hirano discloses a reset register storing the reset signal [col. 4, lines 60-62; col. 5, line 7-col. 6, line 21].

As to claims 14-25, Claims 1, 2 and 7-13 basically are the corresponding elements that are carried out the method of operating steps in claims 14-25. Accordingly, claims 14-25 are rejected for the same reason as set forth in claims 1, 2 and 7-13.

10. Claims 4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kondo (Kondo), U.S. patent no. 6,401,197.

As per claim 4, Kondo discloses a data processing system comprising data processors connected to a common bus, each of the processors performing software initialization using an initialization program after performing initialization in response to a reset signal [fig. 9], and at least one of the processors comprising:

an access inhibiting section inhibiting any access requests to an external memory storing the initialization program, based on a start inhibiting signal, wherein the initialization program is transferred from the external memory to a local memory while the access inhibiting section inhibits any access requests to the local memory [col. 21, line 58-col. 22, line 37; col. 22, lines 57-64].

As per claim 6 is contained the same limitations as claim 3. Therefore, same rejection is applied.

Claim Rejections - 35 USC § 103

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano et al. (Hirano), U.S. patent no. 5,361,365 in view of Spiegel et al. (Spiegel)², US patent no. 6,473,853.

As per claim 3, Hirano discloses that a data processing system performing software initialization using an initialization program after an initialization in response to a reset signal [figures 1, 2], the system comprising:

Hirano is cited for reasons given above. Although Hirano does not teach an access inhibiting section inhibiting any access request to a memory, this is taught by Spiegel. Spiegel teaches the booting (initialization) of a processor [col. 1, lines 48-55] wherein the processor gates an address mask control with an inhibit bit to provide a second address mask control. The inhibit bit is set to prevent improper memory access [col. 6, lines 20-63]. Inherently, Spiegel discloses that an access inhibiting section inhibiting any access request to a memory storing the initialization program based on a start inhibit signal, wherein the initialization program is transferred from an external memory to the memory while the start inhibiting signal is applied.

² Spiegel is a reference cited by applicant.

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Since both references are concerned with processor initialization, It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Spiegel in the system of Hirano.

As per claim 5 is contained the same limitations as claim 3. Therefore, same rejection is applied.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun Cao whose telephone number is 571-272-3664. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 12, 2006



CHUN CAO
PRIMARY EXAMINER